



TTAB

06-21-2001
U.S. Patent & TMO/TM Mail Rpt Dt. #26

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 75/741, 795
Mark: RUSH NEW MEDIA

-----X	:	
RUSSELL SIMMONS	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 122, 816
	:	
KERRY COLIN KEANE	:	
	:	
Applicant.	:	
-----X	:	

**ANSWER, AFFIRMATIVE DEFENSES AND
COUNTERCLAIMS TO NOTICE OF OPPOSITION**

6 JUL -5 PM 5:57

BOX TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Applicant, Kerry Colin Keane, by and through its undersigned counsel, hereby answers and asserts affirmative defenses to the Notice of Opposition of Opposer, Russell Simmons.

1. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 1 of the Notice of Opposition.
2. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 2 of the Notice of Opposition.
3. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 3 of the Notice of Opposition.

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4. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 4 of the Notice of Opposition.

5. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 5 of the Notice of Opposition.

6. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 6(a) of the Notice of Opposition.

7. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 6(b) of the Notice of Opposition.

8. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 7 of the Notice of Opposition.

9. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 8 of the Notice of Opposition.

10. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 9 of the Notice of Opposition.

11. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 10 of the Notice of Opposition.

12. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 11 of the Notice of Opposition.

13. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 12 of the Notice of Opposition.

14. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 13 of the Notice of Opposition.

15. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 14 of the Notice of Opposition.

16. Applicant denies the allegations in Paragraph 15 of the Notice of Opposition.

17. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 15(i) of the Notice of Opposition.

18. Applicant lacks knowledge or information sufficient to form a belief with respect to the allegations set forth in Paragraph 15(ii) of the Notice of Opposition.

19. Applicant denies the allegations set forth in Paragraph 15(iii) of the Notice of Opposition.

20. Applicant denies the allegations set forth in Paragraph 15(iv) of the Notice of Opposition.

AFFIRMATIVE DEFENSES

As and for Applicant's Affirmative Defenses against Opposer's Notice of Opposition, Applicant alleges as follows:

21. The Notice of Opposition fails to state any claim upon which relief can be granted because Opposer's use of its claimed marks are not sufficient trademark use.

22. The Opposer lacks standing to bring this action.

23. Petitioner's claims are barred by the equitable doctrines of laches, waiver, estoppel and/or acquiescence and unclean hands.

24. Opposer's rights in and to Opposer's marks are narrow and limited in scope in light of the numerous third party uses and registrations for the same and/or similar marks.

COUNTERCLAIMS

In the matter of Registration No. 2,457,235 by RUSSELL SIMMONS ("Registrant") for RUSH MEDIA for "advertising agency services; business consultation services in the fields of brand positioning, management, promotion and marketing; market research services; the development and implementation of marketing and brand strategies for others; public relations services; publicity services; marketing services, namely promoting the goods and services of others by preparing and placing print publications, billboards and via a global computer network; media planning and purchase for targeted audiences" in International Class 35, registered on June 5, 2001, KERRY COLIN KEANE, individually and as the owner and sole shareholder of Rush New Media LLC, a limited liability company organized under the laws of New York with its principal place of business at 437 Madison Avenue, 39th floor, New York NEW YORK 10022 ("Counterclaimant"), respectfully alleges as follows:

25. Counterclaimant's principal place of business is 437 Madison Avenue, 39th Floor, New York, N.Y. 10022 ("Applicant").

26. Counterclaimant is the owner of the use-based application for the mark RUSH NEW MEDIA (Serial No. 75/741, 795) filed on June 30, 1999 and published for opposition on January 30, 2001.

27. COUNTERCLAIMANT has used RUSH NEW MEDIA in commerce in connection with "providing entertainment in the nature of games; horoscopes; trivia contests; and book, movie and music reviews by means of a global communications network" in Class 41 since November 30, 1998; and in connection with "providing advice and surveys dealing with adult social relationships by means of a global communications network" in Class 42 since November 30, 1998.

28. Upon information and belief, Registrant is an individual residing at 530 Seventh Avenue, 14th Floor, New York, NY 10018.

29. Upon information and belief, Registrant is the owner of Rush Communications, Inc. located at 530 Seventh Avenue, 14th Floor, New York, NY 10018.

30. Counterclaimant seeks cancellation of Registrant's Registration No. 2,457,235 for RUSH MEDIA for "advertising agency services; business consultation services in the fields of brand positioning, management, promotion and marketing; market research services; the development and implementation of marketing and brand strategies for others; public relations services; publicity services; marketing services, namely promoting the goods and services of others by preparing and placing print publications, billboards and via a global computer network; media planning and purchase for targeted audiences in International Class 35, registered on June 5, 2001.

31. Counterclaimant has, for the past 2 1/2 years, expended considerable sums to create, develop, market, advertise and promote its RUSH NEW MEDIA trademark.

32. Upon information and belief, Registrant's fraudulently obtained the RUSH MEDIA registration by making misstatements concerning the dates of first use as a trademark.

33. Registrant's fraudulent statements resulted in registration being granted for RUSH MEDIA.

34. Registrant's applied for RUSH MEDIA on December 7, 1999, subsequent to the filing on June 30, 1999, of Counterclaimant's application for RUSH NEW MEDIA.

35. Upon information and belief, Registrant sought registration of RUSH MEDIA in bad faith and with knowledge of the existence of Counterclaimant's RUSH NEW MEDIA mark.

36. Upon information and belief prior to the filing its application to register RUSH MEDIA, Registrant used the mark only as a corporate name and failed to use the mark as a trademark in connection with goods and services identified in its application for registration of RUSH MEDIA.

37. Upon information and belief, Registrant did not have a *bona fide* use of RUSH MEDIA in commerce prior to the filing of his application to register the mark.

38. If Registrant is permitted to continue to maintain Registration No. 2,457,235, the registration may be deemed incontestable after five (5) years, and Registrant would thereby obtain an incontestable right to the use of its marks in commerce. The continued existence of such a registration casts a cloud upon Counterclaimant's right to continue to use, register, and expand the use of its trademark RUSH NEW MEDIA. Such registration would thus be a source of damage and injury to Counterclaimant.

WHEREFORE, Counterclaimant deems that it is or will be damaged by Registration No. 2,457,235 and seeks cancellation thereof as it relates to goods in Class 35.

WHEREFORE, Applicant prays that the Notice of Opposition No. 122,816 be dismissed in its entirety, together with the costs and disbursements of this action and such other and further relief as the court may deem just and proper.

This Answer, Affirmative Defenses and Counterclaims are being filed in duplicate. An authorization to charge the deposit account of Greenberg Traurig in the sum of the filing fee of \$300 is attached to the accompanying transmittal letter and hereby authorizes the Commissioner to charge any additional fees it deems necessary in connection with this matter.

Dated: New York, New York
June 21, 2001

Respectfully submitted,
GREENBERG TRAURIG, LLP

By: 

G. Roxanne Elings, Esq.
Sudipta Rao, Esq.
885 Third Avenue
New York, New York 10022
(212) 848-1000

*Attorneys for Applicant,
Kerry Colin Keane*

To: Brad D. Rose, Esq.
Laura M. Franco, Esq.
Pryor Cashman Sherman & Flynn LLP
410 Park Avenue
New York, NY 10022

*Attorneys for Opposer
Russell Simmons*

CERTIFICATE OF MAILING BY EXPRESS MAIL

"Express Mail" mailing label no. EL650640039US

I, Mary L. Au, hereby certify that this correspondence is being deposited as "Express Mail" with the United States Postal Service addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Box TTAB FEE, Arlington, VA 22202-3513 on the date indicated below.

Date of Deposit: June 21, 2001

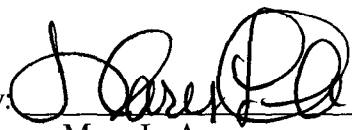
By: 
Mary L. Au

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited on June 21, 2001 with the United States Postal Service as First Class Mail in an envelope addressed to:

Brad D. Rose, Esq.
Laura M. Franco, Esq.
Pryor Cashman Sherman & Flynn LLP
410 Park Avenue
New York, NY 10022

Date of Service: June 21, 2001

By: 
Mary L. Au

GREENBERG
ATTORNEYS AT LAW
TRAURIG

Pawline

G. Roxanne Elings
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June 21, 2001

06-21-2001
U.S. Patent & TMOtc/TM Mail Rept Dt. #26

VIA EXPRESS MAIL EL650640039US

BOX TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: **In the Matter of Application Serial No. 75/741,795**
Mark: RUSH NEW MEDIA
Opposition No. 122,816
Our File: 44037.011900

Dear Sir/Madam:

Enclosed herewith are the following documents:

1. Applicant's Answer, Affirmative Defenses and Counterclaims to Notice of Opposition; and
2. a self-addressed stamped postcard.

The Commissioner is hereby authorized to charge the amount of \$300.00 which is the deficiency in the filing fee associated with this communication only, under 37 CFR §2.6(a) to our Deposit Account No. 501561.

Please acknowledge receipt of the enclosed by placing the received stamp of your mail room on the enclosed postcard and returning it to this office.

BOX TTAB FEE

June 21, 2001

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Thank you for your time and assistance.

Very truly yours,

GREENBERG TRAURIG, LLP

G. Roxanne Elings

Enclosures

cc: Sudipta Rao

"Express Mail" mailing label number: EL650640039US Date of Deposit: June 21, 2001.

I hereby certify that this paper and fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to BOX TTAB FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Mary L. Au